

**REMARKS**

Claims 1 and 4 have been amended to recite, “a starting material of an oleophilic group portion is a primary alcohol and 1 is 9-11....” Support for this amendment can be found on page 6, lines 9-13 of the specification.

Claims 1-21 are pending in the application.

Claim 21 is withdrawn from consideration.

In a telephone interview on December 16, 2005, the Examiner issued a restriction requirement, restricting the claims to group I, claims 1-20, and group 2, claim 21.

In a telephone conference with Examiner Chaudhry on December 28, 2005, Applicants representative elected group I for prosecution on the merits. Applicants confirm this election.

Claims 7-20 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

The Examiner asserts that the phrase “represented by the formula (2)” in claim 7 is vague and indefinite since there is no formula (2) recited in claim 7.

Applicants have amended claim 7 to include formula (2), as in claim 4. Accordingly, Applicants submit that claim 7 is clear and definite. Reconsideration and withdrawal of the rejection is respectfully requested.

The Examiner asserts that there is insufficient antecedent basis for the variables recited in claims 8 and 9.

Applicants have amended claim 7 to include formula (2). Therefore, there is no antecedent basis problem in claims 8 and 9. Reconsideration and withdrawal of the rejection is respectfully requested.

The Examiner also rejects claims 10-20 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for depending from claim 7, 8 or 9.

Applicants have amended claim 7 to include formula (2). Therefore, claims 10-20 are clear and definite. Reconsideration and withdrawal is respectfully requested.

Claims 1-20 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. § 103(a), as allegedly being obvious over Morinaga et al., U.S. Publication No. 2003/0144163 (“Morinaga”).

According to Morinaga, in formulas (2) and (3), R<sup>2</sup> is defined as “an alkyl group...” (column 2, paragraph [0031]). Accordingly, the starting material of the oleophilic group portion disclosed in Morinaga can be a secondary alcohol. The surface active agent produced from a secondary alcohol remains on the surface of the substrate and the removability of particulate foreign substance is insufficient and it does not provide a satisfactory cleaning property (page 6, lines 14-20 of the present specification). See also Table 2, Example 2 and Comparative Example 1 (containing a secondary alcohol) on page 20 of the present specification. From reviewing these examples, it is clear that the number of the fine particles after cleaning is very different and the effects obtained by the present invention is remarkable and unexpected.

Further, according to Morinaga, the carbon numbers of the oleophilic group portion vary widely. That is,  $n \leq 50$  (paragraph [0031]) and  $m \leq 75$  (because the ratio of  $m/n \leq 1.5$  in paragraph [0029]).

On the contrary, according to amended claim 1, the number of carbons of the oleophilic group is 10-12. The comparison with the surface active agent having the carbon number of 8 is shown in Table 4, Comparative Example 6 (page 23 of the specification). It is clear from comparing the inventive Examples with Comparative Example 6 that the contact angles of the present invention are excellent.

In view of the foregoing, Applicants submit that the present invention would not be anticipated or obvious over Morinaga. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

Claims 1-17 and 20 have been rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Takashima, U.S. Publication No. 2004/0142835.

Takashima is § 102(e) prior art to the claimed invention. Takashima was published on July 22, 2004, but Takashima has a filing date of November 6, 2003. Applicants filing date is January 5, 2004, but the present application claims priority from JP 2003-004194 with a filing date of January 10, 2003. Applicants' priority document has an earlier filing date than Takashima. Applicants submit a sworn translation of their foreign priority document, JP 2003-004194 to perfect their claim to priority and remove Takashima as prior art. Applicants submit that JP 2003-004194 supports the pending claims as shown below:

| Claim | Support in Priority Document |
|-------|------------------------------|
| 1     | Claim 1 (page 1)             |
| 2     | Claim 2 (page 1)             |
| 3     | Claim 3 (page 1)             |
| 10    | Claim 4 (page 1)             |
| 11    | Claim 5 (page 1-2)           |
| 12    | Claim 6 (page 2)             |
| 13    | Claim 7 (page 2)             |
| 14    | Claim 8 (page 2)             |
| 15    | Claim 9 (page 2)             |
| 16    | Claim 10 (page 2)            |
| 17    | Claim 11 (page 2)            |
| 18    | Claim 12 (pages 2-3)         |
| 19    | Claim 13 (page 3)            |
| 20    | Claim 14 (page 3)            |
| 21    | Claim 15 (page 3)            |

Additionally, the Examiner asserted that Takashima discloses a surfactant of formulae (I) or (II) at page 3, paragraph 0048 to page 4, paragraph 0067 (page 7 of the Office Action).

Applicants respectfully traverse the Examiner's assertion based on the following remarks.

Applicants submit that the surfactant of Takashima represented by the formula (I) has “-OH” as an end group (see paragraph [0048]), which is different from the surfactant of the present invention in which X is a hydrogen atom or hydrocarbon group.

Additionally, with respect to formula (II) of Takashima, in which R is “R<sup>1</sup>-O” (see paragraph [0050]). Further, according to Takashima, R1 is merely defined as “an alkyl group having with a carbon number of 1 to 20 (see paragraph [0050]). Namely, Takashima does not disclose nor suggest that “a starting material of an oleophilic group portion is a primary alcohol and a is 9-11.”

In view of the foregoing, Applicants submit that the present invention would not be anticipated by Takashima. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

Claims 1-17 and 20 have been provisionally rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-10 of co-pending Application No. 10/702,621, U.S. Publication No. 2004/0142835 (“Takashima”).

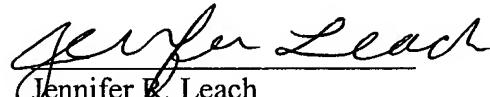
The obviousness-type double patenting rejection above is provisional at the present time. According to the MPEP (section 804), the merits of a provisional rejection *can* be addressed by both the applicant and the examiner without waiting for the first patent to issue (emphasis added). Therefore, Applicants can also choose to defer a response to the provisional rejection until one of the applications is issued as a patent. Applicants respectfully defer the response to the provisional obviousness-type patenting rejection over co-pending Application No. 10/702,621, U.S. Publication No. 2004/0142835 (“Takashima”).

Appln. No.: 10/750,971  
Amendment under 37 C.F.R. § 1.111

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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Date: June 7, 2006